

**AMENDMENT UNDER 37 C.F.R. § 1.116**  
**U.S. Appl. No. 10/500,124 (Q81414)**

**REMARKS**

Claims 1, 4-6, 8-18 and 20-24 are all the claims pending in the application. Applicants incorporate the subject matter of claim 7 into claim 1, and cancel claim 7. Now new matter is added.

**Rejection under 35 U.S.C. 102/103**

Claims 1, 4-18, and 20-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Kodas et al (U.S. Patent No. 6,951,666). The Office Action asserts that Kodas et al discloses each feature of instant claims 1, 4-18 and 20-24. Alternatively, the features claimed would have allegedly been obvious insofar as Kodas et al allegedly discloses each of the claimed ingredients with the claimed proportions for a similar utility.

Instant amended claim 1, from which all claims directly or indirectly depend, recites “the volume resistivity of an electrically conductive coating, which is obtained by coating the electrically conductive coating paste followed by heating, is about  $3.0 \times 10^{-6}$  to about  $8.0 \times 10^{-6}$   $\Omega \cdot \text{cm}$ .” The Office Action mailed March 18, 2008 improperly characterized this feature (formerly in claim 7) as merely a product-by-process limitation. Rather, such a volume resistivity is a structural characteristic of the claimed electrically conductive paste, and it is neither taught nor suggested by Kodas.

Rather, Kodas merely describes a relationship of the bulk resistivity of precursor materials and conductors as compared to that of the bulk conductor. (See for example, Kodas at column 3, lines 1-20; and column 32, line 55-67 to column 1-55). Kodas also defines

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compositions in terms of their sheet resistivity. However, Kodas nowhere discloses or suggests the claimed volume resistivity of about  $3.0 \times 10^{-6}$  to about  $8.0 \times 10^{-6}$ , nor the advantages thereof.

In view of the foregoing, amended claim 1, and all remaining claims depending therefrom, are patentable. Reconsideration and withdrawal of the rejection are earnestly solicited.

**Product By Process Limitations**

With respect to claims 6-9, 11-13, 22 and 23, the Office Action indicates (in the paragraph bridging pages 4-5) that these claims recite product-by-process limitations, and that the product produced would have been obvious.

Applicants respectfully submit that the Office Action has misinterpreted the claim language with respect to at least claims 6-9, 13, and 22-23. For example, instant claim 6 recites “An electrically conductive coating obtained by coating the electrically conductive paste according to claim 1 followed by heating, wherein the silver particles are mutually fused.”

Although the Examiner may not give patentable weight to the phrase “obtained by coating the electrically conductive paste,” the phrase “wherein the silver particles are mutually fused,” is a distinct structural feature of the coating. Likewise, claim limitations relating to volume resistivity, specific gravity, number of pores in the surface area, and the like, previously recited in claim 7, and recited in claims 8-9, 13, 22 and 23 impart distinct structural characteristics to the claimed electrically conductive paste.

Applicants thus submit that the Office did not initially meet its burden of establishing a *prima facie* case of anticipation or obviousness with respect to these claims in the Office Action mailed March 18, 2008. Accordingly, Applicants request that the Office reexamine these claims

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in proper consideration of their structural characteristics. If, in view of the amendments to independent claim 1, the Office believes that any claims in the instant application should remain rejected, Applicant requests that the Office state with specificity the reasons for any such rejection.

In view of the foregoing, and at least because of their direct or indirect dependency upon patentable claim 1, all claims are patentable over Kodas.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The U.S. Patent and Trademark Office is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

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Respectfully submitted,

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